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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
08/838,452	04/07/1997	WARREN M. FARNWORTH	91-62.17	8883

7590 03/13/2003
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EXAMINER

KARLSEN, ERNEST F

ART UNIT	PAPER NUMBER
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2829

DATE MAILED: 03/13/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

08/838,452

Applicant(s)

FARNWORTH ET AL.

Examiner

Ernest F. Karlsen

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-- The MAILING DATE of this communication appears on the cover sheet with the correspond nc address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 17 September 2002.
- 2a) ☒ This action is FINAL. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 78-83 and 87-98 is/are pending in the application.
- 4a) Of the above claim(s) 83,89,94 and 95 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 78-82, 87, 88, 90-93 and 96-98 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

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1. The Examiner does not have access to the file of S.N. 08/073,003. It has apparently been misplaced or lost. For purposes of determining basis of disclosure it is presumed claims 2-4 as originally filed in S.N. 08/073,003 were the same as claims 2-4 as originally filed in the present application.

2. The amendment filed September 17, 2002 is objected to under 35 U.S.C. 132 because it introduces new matter into the disclosure. 35 U.S.C. 132 states that no amendment shall introduce new matter into the disclosure of the invention. The added material which is not supported by the original disclosure is as follows: The range of one half to two thirds is not supported by the original disclosure.

Applicant is required to cancel the new matter in the reply to this Office Action.

3. Claims 78-82, 87, 88, 90-93 and 96-98 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

The limitations based on depth of penetration are considered to be based on new matter. Also the amendments to the last four lines of claim 87 are considered to raise the issue of new matter. The "two to ten times" limitation of claim 87 relates to disclosure found in the second paragraph of page 18 of the specification. What is on page 18 of the specification and what is in claim 87 is not the same.

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4. Claims 78-82, 87, 88, 90-93 and 96-98 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

It is not clear what the claimed limitations would mean in the instance where the pad is less than 5000 Angstroms thick. In claim 97, line 11, it is not clear what is meant by "about".

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. Claims 78-82, 87, 88, 90-93 and 96-98 are rejected under 35 U.S.C. 103(a) as being unpatentable over Agahdel et al in view of Nakano et al.

Agahdel et al show pads 40 with plural particles that protrude from the pads for the same purpose as the protrusions of Applicants' apparatus. Nakano et al show a pad with a point for the same purpose as Applicants' device. The purpose is to limit penetration of a test pad to the height the protrusions extend above the pad. It would have been obvious to one of ordinary skill in the art at the time of the invention to have adapted the point protrusion of Nakano et al for use on the pads of Agahdel et al because one skilled in the art would realize that so doing would enable easy manufacture.

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7. Claims 78-82, 87, 88, 90-93 and 96-98 are rejected under 35 U.S.C. 103(a) as being unpatentable over Agahdel et al.

A pin point if touched to a finger might feel sharp. The same pin point viewed with a magnifying glass might look sharp. The same pin point viewed with a microscope would probably not look all that sharp. The point might be quite rounded. The particles of Agahdel et al are shown as sharp in Figure 4 of Agahdel et al and much less sharp in the magnified view of Figure 5 of Agahdel et al. The particles of Agahdel et al are considered points. With regard to the limitations of depth of penetration one of skill in the art using the apparatus of Nakano et al would know to apply enough pressure to make proper contact and not so much that the pads on the item being tested would be destroyed. The ranges claimed by Applicants are considered the normal ranges that would be used by one skilled in the art and thus obvious.

8. Claims 83, 89, 94, and 95 are withdrawn from further consideration pursuant to 37 CFR 1.142(b) as being drawn to a nonelected inventions and/or species, there being no allowable generic or linking claim. Election was made without traverse in Paper No. 22.

9. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after

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the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Karlsen/ek

03/11/03

A handwritten signature in black ink, appearing to read "Ernest Karlsen". The signature is fluid and cursive, with the first name "Ernest" and last name "Karlsen" clearly distinguishable.

**ERNEST KARLSEN
PRIMARY EXAMINER**